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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,653	06/29/2001	Douglas Calaway	10066-28550	8529

24728 7590 06/27/2005

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EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,653

Applicant(s)

CALAWAY, DOUGLAS

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 and 36-44 is/are allowed.
- 6) ☒ Claim(s) 25-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 25, and 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (Chui) (US 6,657,702).

With regard to claim 25, Chui discloses a method for processing and printing electronic images on a medium comprising the steps of: a) receiving an electronic image file (col 10, lines 45-51); b) associating identification information with the electronic image file (col 14, lines 15-20); c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification

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information (col 14, lines 34-38); d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first to symbol including the identification information (col 14, lines 34-38); e) extracting the identification information from the first symbol (col 14, lines 20-23); and f) printing the identification information read from the first symbol on the medium (col 14, lines 34-38).

With regard to claim 28, Chui also discloses wherein the identification information includes annotation information (col 14, lines 15-20).

With regard to claim 29, Chui also discloses wherein the first symbol is an optically readable barcode (Figure 9, barcode 910, col 21, lines 40-51).

With regard to claim 30, Chui also discloses wherein the printed identification information includes a second symbol (col 14, lines 15-20).

With regard to claim 27, Chui also discloses wherein the identification information includes an order number and a customer number (col 14, lines 15-20).

With regard to claim 31, Chui also discloses wherein the means for reading the plurality of first barcodes is an optical scanner (Figure 9, barcode 910, col 21, lines 40-51; col 1, lines 43-48).

With regard to claim 32, Chui also discloses wherein the means for printing the information is an ink jet print-head (which reads on printing with any physical manifestation being printed by an inkjet printer) (col 1, lines 58-62; col 14, lines 59-65).

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3. Claims 25, and 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Redd et al. (Redd) (US 6,646,754).

With regard to claim 25, Redd discloses an annotation printer apparatus (print lab system 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information (col 21, lines 61-65col 26, lines 9-55); b) means (printer 622, backprinter 634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it corresponds (col 17, line 51 – col 18, line 15; col 26, lines 30-36); and C) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol (col 19, line 26 – col 20, line 33).

With regard to claim 33, Redd also discloses wherein the means for regulating the movement of the medium through the apparatus includes a computer, wherein the computer is connected to sensors for sensing the speed the medium moves through the apparatus, for determining when the printing means prints the information so that the information is printed proximate to the corresponding image (col 19, line 26 – col 20, line 33).

With regard to claim 34, Redd also discloses wherein the means for regulating the movement of the medium through the apparatus further comprises: an electric motor

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with an attached drive pulley, the speed of which is regulated by the computer based on the sensed speed of the medium, for motivating the medium; and a drive system including a plurality of pulleys, wherein a separate pulley is attached to the motor, a supply spool, a take-up spool, and two capstans, the pulleys driven by a plurality of belts attached to the drive pulley of the motor (col 25, line 43 – col 26, line 8).

With regard to claim 35, Redd also discloses wherein the computer (computer system 100; 320) is adapted to communicate with a server computer via a network, for retrieving an annotation associated with the identification information read from the first bar code, the computer further adapted to cause the printing means to print the annotation on the medium proximate to the composite image to which it corresponds (col 3, lines 11-29; col 10, lines 32-49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al. (Chui) (US 6,657,702) in view of Redd et al. (Redd) (US 6,646,754).

With regard to claim 26, Chui also discloses wherein the medium is printed, but it does not clearly teach that the medium is a continuous roll of photographic paper.

Redd discloses a system for backprinting image prints wherein the medium is a continuous roll of photographic paper (Figure 12, col 21, lines 38-42).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Chui to include the print medium being a continuous roll of photographic paper as taught by Redd. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Chui by the teaching of Redd to allow successive printing onto successive portions of a roll of print paper as taught by Redd in col 21, lines 38-42.

Response to Arguments


6. Applicant's arguments, see Amendment, filed 3/21/05, with respect to 1-24 and 36-44 have been fully considered and are persuasive. The rejections of claims 1-24 and 36-44 have been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler M. Lamb whose telephone number is 571-272-7406. The examiner can normally be reached on Mon, Tues and Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Twyler M. Lamb
Primary Examiner
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